

## REMARKS

### **1. Status of Claims**

Claims 1-13 and 16-20 were pending in the Application. Pending the re-opening of prosecution, the rejections of Claims 1-13 and 16-20 by the Examiner stand affirmed by the Board Of Patent Appeals and Interferences (“the Board”). In the Board’s Decision, the Board affirmed the Examiner’s rejection of Claims 1-13 and 16-20, but entered a new ground of rejection for Claims 16-20 under 37 C.F.R. § 41.50(b). In response, Applicant has elected to reopen prosecution. Accordingly, Applicant has amended claim 16 and canceled Claims 1-13 without prejudice or disclaimer. Applicant respectfully requests entry of the above amendment and consideration of the enclosed remarks. Applicant submits that no new matter is added. Accordingly, Claims 16-20 will remain pending in the application.

### **2. Rejections under 35 USC § 101**

In the Board’s Decision, the Board rejected Claims 16-20 as allegedly being directed to non-statutory subject matter. In response, Applicant has amended Claim 16 to be directed more clearly to statutory subject matter. Accordingly, Applicant respectfully traverses the rejection.

The Board further explained the basis of their rejection by stating that “Claim 16 recites a series of steps needed to make a decision as to whether to offer an incentive and modify that incentive,” but that there is “no transformation of subject matter occurring in these series of steps.” Because Claim 16 does not transform or otherwise reduce subject matter into a different state or thing, the Board held that Claim 16 is not directed to a statutory “process.”

Applicant has amended Claim 16 to clarify that the steps of Claim 16 include “offering the customer the incentive by updating a rate database maintained by the carrier information system for the customer” and “modifying the incentive by updating the customer’s rate database” (emphasis added). These amendments clarify that

Claim 16 is directed to a method for determining targeted incentives that involves updating incentive information in a customer's rate database. In other words, the subject matter of Claim 16 (i.e. the incentive information) is being updated in the customer's rate database. Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of Claim 16.

### **3. Rejections under 35 USC § 102(b)**

In the Board's Decision, the Board also rejected Claims 16 as allegedly anticipated by US Patent No. 5,995,950 issued to Barns-Slavin et al. (hereinafter "Barns-Slavin '950"). The Board stated that Applicant argued claim limitations that were not claimed. Applicant has amended Claim 16 to include such claim limitations. Applicant respectfully traverses the rejection.

Barns-Slavin '950 describes a carrier management system that uses predetermined requirements to determine if a discount should be applied to a rate database for a group of parcels that are being shipped to a single consignee. See Barns-Slavin '950, col. 2, lines 20-48. Barns-Slavin does not teach, disclose or suggest (i) analyzing incentive related usage data; (ii) determining effectivity of the incentive; (ii) determining whether to modify the incentive based on the effectivity of the incentive; and (iv) modifying the incentive by updating the customer's rate database. The Board stated, however, that "determining the effectivity of the incentive" and "determining whether to modify the incentive based on the effectivity" were not claimed. Therefore, Applicant has amended Claim 16 to include such limitations.

Applicant respectfully submits that Barns-Slavin '950 does not teach, disclose or suggest at least the following underlined portions of Claim 16:

16. A method for determining targeted incentives using a carrier information system having feedback comprising:
  - obtaining customer usage and customer data;
  - determining whether offering an incentive is desired;
  - determining whether a customer is eligible for the incentive;

offering the customer the incentive by updating the customer's rate database;  
obtaining incentive related usage data;  
analyzing the incentive related usage data;  
determining the effectivity of the incentive;  
determining whether to modify the incentive based on the effectivity of said incentive; and  
modifying the incentive by updating the customer's rate database.

Accordingly, Applicant respectfully requests that the Examiner withdraw the rejection of Claim 16.

#### **4. Conclusion Of Remarks**

For at least the reasons stated above, it is respectfully submitted that the Claims 16-20 of this application are in condition for allowance and early and favorable action thereon is requested. Pursuant to the Board's Decision, Applicant reserves the right to seek review under 35 U.S.C. §§ 141 or 145 with respect to the Board's affirmed rejections of Claims 1-13 and 16-20.

If the Examiner believes that additional issues may be resolved by a telephone interview, the Examiner is respectfully urged to telephone the undersigned attorney for Applicant at (203) 924-3453.

#### **5. Authorization**

No fee is believed due with this Amendment. However, the Commissioner is hereby authorized to charge any additional fees which may be required for the response or credit any overpayment to the Pitney Bowes Inc. Deposit Account Number 16-1885, Order No. F-506.

In the event that an extension of time or additional extension of time is required to make this response timely filed, the Commissioner is requested to grant a petition for that extension of time which is required to make this response timely. The Commissioner is hereby authorized to charge any fee for such an extension of time

or credit any overpayment for an extension of time to the Pitney Bowes Inc. Deposit  
Account Number 16-1885, Order No. F-506.

Respectfully submitted,

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